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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SATOSHI MIKAMI, MASAHIRO SANO and
TAKAHARU YASUE

Appeal 2007-4457
Application 09/341,328
Technology Center 1600

Decided: February 29, 2008

Before ERIC GRIMES, RICHARD M. LEBOVITZ, and FRANCISCO C.
PRATS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a skin contacting article. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.¹

¹ In this decision we consider only those arguments actually made by Appellants. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).

STATEMENT OF THE CASE

Claims 12-41 are pending and on appeal (App. Br. 2).² Appellants state that “[t]he claims all stand or fall together” (*id.* at 6).

Claim 12 is representative of the appealed claims and reads as follows:

12. A skin contacting article used in contact with the skin, said article comprising a base layer and natural organic impalpable powder firmly adhered to a side of the base layer which contacts with the skin, the powder being adhered to the base layer by coating a treatment comprising the powder onto the base layer and drying the treatment thereon.

The Examiner applies the following documents in rejecting the claims:

Mellul	US 5,496,544	Mar. 5, 1996
Lagrange	US 5,776,497	Jul. 7, 1998

The following rejections are before us for review:

Claims 12-41 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Mellul (Ans. 4-5).³

Claims 12-41 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Lagrange (Ans. 5-6).

OBVIOUSNESS -- MELLUL

ISSUE

The Examiner cites Mellul as disclosing “a cosmetic composition for skin consisting of a powder and a silicon resin mixture” (Ans. 4). The Examiner contends that Mellul’s disclosure of starch as a filler in the powder

² Supplemental Appeal Brief filed February 26, 2004.

³ Examiner’s Answer mailed February 14, 2005.

composition “fulfills the requirement for a natural, organic material in the powder composition” (*id.*).

The Examiner cites Mellul as disclosing that “powder puffs, applicators, and sponges are well known in the cosmetic art to apply facial powder and the like to the skin,” and therefore finds that “one of ordinary skill in the art would have been motivated to use a well known applicator (as discussed by Mellul et al.) to apply a cosmetic composition comprising a powder and a silicone resin mixture, as taught by Mellul” (*id.* at 5). Based on these findings, the Examiner concludes that “this invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made” (*id.*).

Appellants contend that “nothing in this reference suggests that the powder is firmly adhered to the applicator through a process of coating a treatment comprising the powder onto the base layer and drying the treatment thereon so that the cosmetic composition is firmly adhered to the base layer” (App. Br. 7). Appellants also contend that “although this reference discloses that inorganic and organic pigments can be contained in the cosmetic composition, there is no disclosure in this reference of the cosmetic composition containing natural organic impalpable powder as required by the currently presented claims” (*id.*).

The issue with respect to this rejection, therefore, is whether the Examiner erred in concluding that Mellul would have rendered obvious, to a person of ordinary skill in the art, an article having a natural organic impalpable powder firmly adhered to a base layer.

PRINCIPLES OF LAW

Recently addressing the issue of obviousness, the Supreme Court reaffirmed “the conclusion that when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007) (quoting *Sakraid v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)). The Court reasoned that a “patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Id.* at 1739 (quoting *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950)).

The Court also stated that “[i]n determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *Id.* at 1741-42.

When evaluating whether a claim extends to obvious subject matter, the PTO must interpret the claim’s terms using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

However, “while ‘the specification [should be used] to interpret the meaning of a claim,’ courts must not ‘import[] limitations from the specification into the claim.’ . . . [I]t is improper to ‘confine the claims to th[e] embodiments’ found in the specification” *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 1299 (Fed. Cir. 2007) (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed.Cir.2005), citations omitted, bracketed text in internal quotes in original); *see also Sjolund v. Musland*, 847 F.2d 1573, 1581 (Fed. Cir. 1988) (“[W]hile it is true that claims are to be interpreted *in light of* the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims.”); *In re Bigio*, 381 F.3d 1320, 1325 (Fed Cir. 2004) (“[A]bsent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification . . . when [it] expressly disclaims the broader definition.”).

Also, while claims under examination must be given their broadest reasonable interpretation, in *In re Buszard*, 504 F.3d 1364, 1367 (Fed. Cir. 2007), the Federal Circuit recently reversed an anticipation rejection, holding that it was unreasonable to interpret a claim to encompass a prior art product where “a person of ordinary skill in the field” would have recognized that the two products were different, and where the specification and claims had “specifically state[d]” that the claims required a particular product. *Id.*

It is “well settled that the presence of process limitations in product claims, which product does not otherwise patentably distinguish over the prior art, cannot impart patentability to that product.” *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1318 (Fed. Cir. 2006) (quoting *In re*

Stephens, 345 F.2d 1020, 1023 (CCPA 1965). As stated in *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985) (citations omitted):

[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Also, once the Examiner makes a *prima facie* showing that a prior art product renders a product-by-process claim unpatentable, Appellants bear the burden of proving “that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.” *Id.* at 698 (quoting *In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977)).

FINDINGS OF FACT

1. Claim 12 recites an article which is intended to be contacted with the skin. The article has a base layer and a natural organic impalpable powder which is firmly adhered to a side of the base layer. The powder is adhered to the base layer by coating a “treatment” that contains the powder onto the base layer and then drying the treatment on the base layer.
2. The Specification does not define “impalpable powder.” However, *Merriam Webster’s Deluxe Dictionary* 916 (10th Collegiate ed. 1998) defines “impalpable” as “so finely divided that no grains or grit can be felt (rock worn to an *impalpable* powder).”
3. The Specification does not define “treatment.” However, the Specification states:

The treatment can be obtained by: adding the natural organic impalpable powders having average particle size of less than 30 μm to an at least one dispersion medium selected from water, an organic solvent, a resin emulsion and a resin aqueous solution so that the content of the natural organic impalpable powder is 0.5 to 50 wt.%; stirring; and dispersing the natural organic impalpable powders. When the resin emulsion or the resin aqueous solution is used as the dispersion medium, the treatment is conditioned so that the solid resin content is 0.5 to 20 wt.%.

The treatment is coated to and dried on the base of surface material 11 for sanitary articles according to the present embodiment so that the natural organic impalpable powder is adhered thereto.

(Spec. 7-8.)⁴

4. Mellul discloses “a cosmetic composition for the skin, in the form of an anhydrous powder mainly comprising a solid particulate phase mixed with a fatty binder containing a silicone mixture” (Mellul, col. 2, ll. 48-51). Mellul discloses that “[t]he particulate phase of the composition consists of the pigments and/or fillers customarily used in such cosmetic compositions” (*id.* at col. 5, ll. 18-20). Mellul discloses that suitable fillers include “modified or unmodified starch, in particular rice starch” (*id.* at col. 6, l. 9).

5. Mellul discloses that its powder compositions “may be provided especially in the form of blushers, eye shadows, face makeup powders, body powders (perfumed and/or deodorizing), including foot powders and the like” (Mellul, col. 7, ll. 15-18). Mellul states that its powder compositions “are generally used by removing a small quantity of powder and then applying to the skin by means of an applicator (sponge, powder puff or brush)” (*id.* at col. 1, ll. 20-23).

⁴ Substitute Specification filed August 4, 2000.

6. Mellul states that cosmetic compositions “should have a smooth feel” (Mellul, col. 1, ll. 28-29). Example 2 of Mellul discloses a “[c]ompacted face powder” which “exhibits great smoothness on application” (Mellul, col. 8, ll. 33-54). Example 3 of Mellul discloses an “[e]ye shadow” that “is easy to apply and has great smoothness” (*id.* at col. 8, l. 56, through col. 9, l. 18).
ANALYSIS

We agree with the Examiner that Mellul would have rendered an article encompassed by claim 12 obvious to a person of ordinary skill in the art. Specifically, because Mellul discloses that starch, a natural organic powder, is a desirable filler in its cosmetic powders (*see* Finding of Fact (“FF”) 4, above), we agree with the Examiner that a person of ordinary skill in the art would have been prompted to use starch powder in an article that contacts the skin. Because Mellul discloses the desirability of smoothness in cosmetic powders (*see* FF 6), we agree with the Examiner that a person of ordinary skill in the art would have been prompted to ensure that the starch powder was impalpable, that is, did not contain any grains or grit.

Also, because Mellul discloses that its powders are generally applied to the skin using an applicator such as a sponge, powder puff, or brush (FF 5), we agree with the Examiner that a person of ordinary skill in the art would have considered it desirable for the impalpable powder-containing composition to be adhered to the applicator firmly enough to allow application of the powder by the applicator. Therefore, because a person of ordinary skill in the art viewing Mellul would have considered an article having all of the structural requirements recited in claim 12 to be desirable, we agree with the Examiner that claim 12 would have been *prima facie* obvious in view of Mellul.

Appellants argue that nothing in Mellul “suggests that the powder is firmly adhered to the applicator through a process of coating a treatment comprising the powder onto the base layer and drying the treatment thereon so that the cosmetic composition is firmly adhered to the base layer” (App. Br. 7). We are not persuaded by this argument.

Claim 12’s recitation, “the powder being adhered to the base layer by coating a treatment comprising the powder onto the base layer and drying the treatment thereon,” limits the method by which the claimed article is made. We therefore interpret claim 12 as a product-by-process claim.

As noted above, “[i]f the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985). As also noted above, once the Examiner makes a prima facie showing that a prior art product renders a product-by-process claim unpatentable, Appellants bear the burden of proving “that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.” *Id.* at 698 (quoting *In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977)).

In the instant case, according to the Specification, “coating a treatment comprising the powder onto the base layer and drying the treatment thereon” can simply mean drying a solution of the powder in water onto the base layer (*see* FF 3). Because drying removes water, such a process would appear to leave only a powder composition adhered to an applicator. Thus, because the compositions suggested by Mellul contain a powder composition adhered to an applicator, we agree with the Examiner that it

was reasonable to conclude that the starch powder-containing articles suggested by Mellul meet the structural limitation recited in claim 12.

Appellants have not explained why, nor have they provided any evidence showing that, the prior art processes of applying the powder to the applicators would have resulted in articles that are structurally different from those claimed. Nor have Appellants shown that the prior art articles could not be made by a process which dried a solution of the powder onto the applicator. Appellants therefore have not met their burden in establishing that the articles suggested by Mellul are structurally different from those recited in claim 12.

Appellants contend that according to “the 10th edition of Merriam Webster's Collegiate Dictionary, the definition of firmly is ‘securely or solidly fixed in place’ and the definition of adhered is ‘to hold fast or stick by or as if by gluing, suction, grasping, or fusing’” (App. Br. 8). Therefore, Appellants argue, when given its ordinary, accustomed, or dictionary meaning, “‘firmly adhered’ means that the natural organic impalpable powder of the present invention is permanently affixed to a side of the base layer of the skin contacting article which contacts with the skin” (*id.*) Appellants urge that, because nothing in the Specification suggests that Appellants intended “firmly adhered” to have any meaning other than its accustomed, ordinary, or dictionary meaning, “there is no basis for the Examiner to suggest that the powder cosmetic composition of Mellul et al reads on the currently presented claims when it is contained on an applicator prior to being applied to the user” (*id.*; *see also* Reply Br. 2-3).

We are not persuaded by this argument. As noted above, during examination claim terms must be must be interpreted using “the *broadest*

reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (emphasis added).

In urging that "firmly adhered" means "permanently affixed" (App. Br. 8) Appellants are, in our view, reading claim 12 significantly more narrowly than would a person of ordinary skill giving the claim its broadest reasonable interpretation. Considering "adhere" to mean "hold fast . . . by . . . grasping" (App. Br. 8) suggests that the hold need not be permanent, inasmuch as a grasp is not necessarily a permanent thing. Thus, while "firmly" means "securely or solidly fixed in place" (App. Br. 8), one of ordinary skill would reasonably conclude that that definition does not require permanent attachment when viewed in the context of the definition for "adhere."

Therefore, because a person of ordinary skill in the art would reasonably interpret the definitions of "firmly" and "adhered" taken together to encompass a secure but impermanent grasp, we do not agree with Appellants that the meaning of the recitation "firmly adhered" should be narrowed to require the powder to be permanently affixed to the base layer. Rather, we agree with the Examiner that "firmly adhered" encompasses powders which are adhered to an applicator firmly enough to allow the powder to be applied to the skin by an applicator. As stated in *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989), "during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed."

Appellants argue that there is no disclosure in Mellul “of the cosmetic composition containing natural organic impalpable powder as required by the currently presented claims” (App. Br. 7). Appellants urge that “although Mellul et al discloses that starch can be contained in the powder composition of the filler, there is no disclosure in this reference that the starch is added to the filler as an organic impalpable powder” (*id.* at 8-9).

We are not persuaded by this argument. Because Mellul discloses that starch is a powder that can be obtained from rice (*see* FF 4), we agree with the Examiner that claim 12’s recitation “natural organic powder” encompasses starch. Moreover, as noted above, because Mellul discloses the desirability of smoothness in cosmetic powders (*see* FF 6), we agree with the Examiner that a person of ordinary skill would have been prompted to ensure that the starch powder was impalpable, that is, did not contain any grains or grit.

Thus, because we agree with the Examiner that a person of ordinary skill in the art viewing Mellul would have considered an article meeting all of the claimed limitations to be desirable, we agree with the Examiner that claim 12 would have been obvious in view of Mellul. We therefore affirm the Examiner’s obviousness rejection of claim 12 over Mellul. Because “[t]he claims all stand or fall together” (App. Br. 6), we also affirm the Examiner’s obviousness rejection of claims 13-41 over Mellul.

OBVIOUSNESS -- LAGRANGE

ISSUE

The Examiner cites Lagrange as disclosing a cosmetic powder having organic particles which can be applied with a powder puff or a brush (Ans. 6). The Examiner contends that a person of ordinary skill in the art “would look to the teachings of Lagrange et al. to formulate a cosmetic composition comprising an applicator, and a powdered substance wherein the powdered substance is firmly adhered to the applicator. Without firm adherence, the applicator would not function as desired” (*id.*).

Appellants contend that although Lagrange “discloses that the inventive powder can be applied with a powder puff or brush, there is no disclosure in this reference regarding the powder being firmly adhered to a side of a base layer” (App. Br. 9). Appellants contend that interpreting Lagrange as firmly adhering its powder to the powder puff or brush “would in fact destroy the object of this reference since the powder disclosed there is a cosmetic preparation which is to be applied to the skin and/or exoskeleton” (*id.*; *see also* Reply Br. 2-3).

The issue with respect to this rejection, therefore, is whether the Examiner erred in concluding that Lagrange would have rendered obvious, to a person of ordinary skill in the art, an article having a natural organic impalpable powder firmly adhered to a base layer.

FINDINGS OF FACT

7. Lagrange discloses “a powder consisting of inorganic or organic particles containing an indoline-based product in and/or on the particles” as well as “the cosmetic application of such powders” (Lagrange, col. 1, ll. 50-56). Lagrange discloses that the organic particles used “are fine particles of

polymers” (*id.* at col. 5, l. 10) having an “especially” preferred size “between 0.1 and 20 microns” (*id.* at col. 5, l. 20), with suitable polymers including keratin, chitin, cellulose, and silk (*id.* at col. 5, ll. 35-45).

In Example 6, Lagrange discloses a “compact face powder” embodiment which is “applied with a powder puff or brush” (*id.* at col. 13, l. 65, through col. 14, l. 13).

8. Appellants’ Specification discloses that the natural organic material making up the impalpable powder “is, for instance, silk . . . , cellulose, chitin, . . . and the like” (Spec. 2). The Specification also discloses that “the natural organic impalpable powder preferably has an average particle size of less than 10 μm . The lower limit of the natural organic impalpable powder is preferably more than 0.1 μm , more preferably more than 1 μm ” (*id.* at 4).

ANALYSIS

We agree with the Examiner that Lagrange would have rendered an article encompassed by claim 12 obvious to a person of ordinary skill in the art. Specifically, Lagrange discloses powders composed of the same substances as those described in Appellants’ Specification as being natural and organic (*see* FF 7-8). The particles in Lagrange’s natural powders are within the size range disclosed by Appellants as being suitable for impalpable powders (FF 7-8).

Furthermore, Lagrange discloses that powders having those properties are suitable for cosmetic applications (FF 7). In view of Lagrange’s disclosure of applying a “face powder” with “a powder puff or brush” (FF 7), we agree with the Examiner that a person of ordinary skill in the art would have been prompted to adhere Lagrange’s natural organic cosmetic powder compositions to an applicator, such as a powder puff or brush,

sufficiently firmly to allow the applicator to apply the powder to a user's skin.

We do not agree with Appellants that this interpretation of Lagrange “destroy[s] the object of this reference since the powder disclosed there is a cosmetic preparation which is to be applied to the skin and/or exoskeleton” (App. Br. 9). Rather, we agree with the Examiner that a person of ordinary skill would have reasoned that, in order to use a powder puff or brush to apply Lagrange's powder-containing composition, the composition would have to adhere to applicator firmly enough to allow application. Moreover, for the reasons discussed above, by reading “firmly adhered” to require the attachment between the powder and the base to be permanent, Appellants are significantly narrowing the claims' scope away from the “broadest reasonable” interpretation that must be applied during examination. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Therefore, because we agree with the Examiner that Lagrange would have suggested an article meeting all of the claimed limitations to a person of ordinary skill in the art, we affirm the Examiner's obviousness rejection of claim 12. Because “[t]he claims all stand or fall together” (App. Br. 6), we also affirm the Examiner's obviousness rejection of claims 13-41 over Lagrange.

SUMMARY

We affirm the Examiner's rejection of claims 12-41 under 35 U.S.C. § 103(a) as obvious in view of Mellul.

We affirm the Examiner's rejection of claims 12-41 under 35 U.S.C. § 103(a) as obvious in view of Lagrange.

Appeal 2007-4457
Application 09/341,328

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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